



PATENT
Docket No.: J2167.0061/P061

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Dated: January 16, 2003

Signature: *Michael J. Scheer*

(Michael J. Scheer)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Deborah Everling, et al.

Serial No.: 09/204,390

Group Art Unit: 2164

Filed: December 2, 1998

Examiner: J. Pwu

For:

MERCHANT TRANSACTION
DATA MINING METHOD

Box DAC
Assistant Commissioner for Patents
Washington, D.C. 20231

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**RENEWED PETITION TO WITHDRAW HOLDING OF
ABANDONMENT UNDER 37 C.F.R. § 1.181(a)**

On February 26, 2002, Applicants received a Notice of Abandonment (attached as Exhibit A), dated February 12, 2002. The Notice states that the above-referenced application is being held abandoned due to Applicants' failure to timely respond to the Office Action that was mailed by the Patent Office on June 11, 2001 (the "June 11th Office Action). The Applicants request that the holding of abandonment in this case be withdrawn for the reasons set forth below.

If an applicant fails to respond to an Office Action on time because he never received it, the Patent Office may withdraw its holding of abandonment provided that:

the applicant includes a statement from the practitioner stating that the office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office Action was not received. A copy of the docket where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

M.P.E.P. § 711.03(c)(ii). See also Withdrawing the Holding of Abandonment When Office Actions Are Not Received, 1156 O.G. 53 (Nov. 16, 1993).

On February 4, 2002, I spoke to the Examiner who confirmed that in June of 2001, the June 11th Office Action was mailed to my office, then located at the law firm of Ostrolenk, Faber, Gerb & Soffen, LLP ("Ostrolenk"), 1180 Avenue of the Americas, New York, NY, 10036.¹ However, I never received a copy of the June 11th Office Action.²

I examined the front of the file jacket for this case, a copy of which is attached as Exhibit C. Recorded in the area labeled "ACTIONS," is the mailing date and type of each Office Action received for this case. When an Office Action is received by Ostrolenk, a docketing clerk makes an entry in the "ACTIONS" area indicating the type of action and the

¹ In January 2002, I left Ostrolenk and joined the law firm of Dickstein, Shapiro, Morin & Oshinsky LLP.

² Enclosed as Exhibit B is a letter from Edward A. Meilman granting me, Michael J. Scheer, power of attorney in this case.

mailing date of the action. However, there is no entry in the front of the file that an Office Action with a mailing date of June 11, 2001 was ever received. This is an indication that Ostrolenk never received the Office Action.

I also examined Ostrolenk's docketing records to determine whether the Office Action had ever been docketed. Ostrolenk uses a computerized patent docketing system called CPI. A printout of Ostrolenk's CPI docket report for this case is attached as Exhibit D. Whenever an Office Action for a particular matter is received by Ostrolenk, a docketing clerk enters information about the received Office Action, including its mailing date, in CPI. CPI then automatically calculates deadlines based on the filing date, and generates reminders that a response is required.

I examined the CPI docket report for this case. It includes a table labeled "List of Actions." The first column of this table states what action is due, and the second column lists the due date for that action in monthly intervals, culminating with the six-month statutory deadline. The third column describes the type of deadline represented by the due date listed in the second column. There are three descriptions used in the third column: Due Date, Final Date, and Reminder. Final Date means that the due date listed in the second column is the sixth-month date. Due Date means that the due date listed in the second column is a date that is extendible by request. Reminder means that the date is neither a Due Date or a Final Date. Finally, the fourth column lists the date that any action was taken by the applicant with respect to the action due (listed in the first column).

The printout of the CPI docket report, however, does not contain an entry for the June 11th Office Action. This further indicates that Ostrolenk never received the Office Action.

Ostrolenk also uses a manual backup docketing system in addition to the CPI system. When an Office Action is received at Ostrolenk, a docket clerk at Ostrolenk makes an entry in the manual docket. The entry is made under the date that the sixth-month deadline for a response is due to expire. The first column of the manual docket entry contains the initials of the name of the responsible attorney. The second column contains the Ostrolenk docket number of the case. The third column contains the U.S. Patent Application Number of the case. The fourth column contains a description of the action that must be taken by that particular date. Finally, the fifth column contains the date that any action may have been taken.

I examined Ostrolenk's manual docket entry for the dates of December 8 through 13, attached as Exhibit E. I examined these particular dates because, if Ostrolenk had received the June 11th Office Action, the docketing clerk would have made an entry on or about December 11th (the sixth-month date). However, Ostrolenk's manual docket does not show that a response to the June 11th Office Action was due. In fact, the manual docket does not contain any entry for this case whatsoever. Again, the lack of any entry relating to the June 11th Office Action in either the CPI or manual dockets indicates that Ostrolenk never received the Office Action.

Moreover, both the front of the file jacket and the CPI report show that on December 7, 2001 – four days before the end of the six-month response period – I wrote a letter to the Examiner (attached as Exhibit F) informing him that I had yet to receive the anticipated Office Action and asking him to advise me of the status of the application. I would not have written such a letter had there been any indication that an Office Action was due.

All of the above-described circumstances indicate that the June 11th Office Action was never delivered to Ostrolenk. As a result, I respectfully ask that the Patent Office withdraw its holding of abandonment of this application.

Dated: January 16, 2002

Respectfully submitted,

By


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